(New) 35. A method of constructing a label which is easily alignable, the method comprising the steps of:

providing a label having a first layer having a top surface adapted to being printable;

applying an adhesive configured to form an axial channel, such that it defines a visually discernible gap;

wherein the combination of first layer and adhesive has different light transmission properties than the first layer alone, thereby creating a discernible gap at the channel;

wherein the axial channel is of sufficient width to create a single fold line when a folding force is applied to the label.

REMARKS

This is response to the action mailed 24 March 2003 for which a petition for reinstatement has been simultaneously filed. In the event that this response also requires an extension of time, please consider this such a request and draw the necessary fees from the undersigns deposit account number 50-1038.

In the action, claims 1-5, 8, 30-32 and 34 were rejected under 35 U.S.C. §102(a) as being anticipated by Cunningham (U.S. 2,893,144). Claims 6, 7, 9-29 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cunningham (U.S. 2,893,144). For clarification, we describe the differences between Cunningham and the present invention.

Claim 1

The present invention is defined in the claim as a two-layer label. The first layer is substantially flat, and is capable of being printed upon. The second layer includes two sections with a gap between them, and the gap defines a fold line, so that when the label is folded over the edge of a sheet, the two sections may be attached to opposite sides of the sheet.

In combination, these two layers ensure that the label will be printed and placed accurately and consistently. Because the first layer is substantially flat, the label is suitable for use in sheet-feed printers, such as a laser printer or photocopier, which may

have difficulty printing reliably on textured features such as a score line or perforations.

In contrast with the device in Cunningham, does not recognize the importance of being able to provide a universal label, i.e. one that can be handwritten and printed and printed by a multitude of printer types.

Cunningham uses layers that are not at all planar (note the curvature between 15 and 16 in Fig. 5). Indeed, one of the embodiments allows for the insertion of opaque inserts (31 in Fig. 8), requiring a substantial clearance between the first and second sections of the second layer. While this variable thickness may be tolerated if the labels are delivered in rolls and printed by printers which have twin spaced apart print heads, but would be an utter failure if such a label was printed on a sheet feed laser or ink-jet printer as these thickness variations are unacceptable.

Indeed, it would be impossible to use Cunningham's device in typical sheet-feed printers. Because sheet-feed printers typically have a mechanical gate that prevents more than one sheet from being fed through at a time (as a means to separate the sheets) , any thickness variations would certainly cause jams at the gate. Even if Cunningham's device were to pass through the mechanical gate, the thickness variations might damage the jets in a laser printer, or might damage the drum in a photocopier, and would certainly produce inferior printing on the labels themselves.

Consequently, the application of the Cunningham reference to this claim as a sec 102 rejection is inapplicable, but also as a sec 103 rejection because there is 1) no recognition of a universally printable label technology and 2) there is no teaching whatsoever of how to solve the problem, even if it were recognized, and 3) the references actually teaches away from the present invention because it shows only a non planar structure, even though the possibility of a planar structure could have been shown. Quite simply, Cunningham simply did not recognize nor solve the problem of the present invention.

Claims 2

Claims 2 contains similar elements as claim 1 and an adhesive layer, not taught by Cunningham.

Claims 3-5

The second layer is divided into two sections by a gap. The gap may be a series of perforations or other features rather than a spaced apart relationship, allowing for potential simplifications in any required manufacturing steps. Stated another way, the two sections of the second layer are close together but there is some what do define the fold line visually.

The presence of a gap in the second layer of the present invention ensures that the labels will fold predictably, with the fold line occurring exactly at gap for every label. In Cunningham's device, the spacing between the first and second sections of the second layer (13,14) enables folding of the two halves without stressing the central portion of the strip material, but does not uniquely determine where the fold will occur. Said another way, the fold may occur in a plurality of locations in Cunningham's device, but is uniquely determined by the gap in the present invention.

In addition, because the gap is visible to the user (and because the user will therefore know exactly where the label will fold), the label may be printed by a method that uses manual placement of the characters (as opposed to a sheet-fed device), such as a rubber stamp or a typewriter. The labels may also be handwritten, since the user would clearly see the gap.

Claim 6

Claim 6 describes a fold-line section that is offset from a centerline of the first layer. Cunningham discloses only a central symmetric fold-line. In fact, all eight of the figures in Cunningham show a symmetry in the fold-line. Indeed, if the fold-line were deliberately moved away from the centerline of the first layer, the shown manufacturing process would not work, as Cunningham would require refabrication of the dies (19 in Fig. 3), which are designed to punch symmetric openings (20) in the tabs.

Claim 7

Claim 7 describes a second layer that has at least two gaps, enabling folding upon a thick tab member. Cunningham uses different thicknesses for the first and second sections, and cites cardboard as a potential material for the tabs. Cardboard can be manufactured quite thick, and since Cunningham's device is distributed on a roll, not fed through a printer, a relatively thick material is quite acceptable. Consequently,

Cunningham has chosen a different solution to the problem of creating a thick tab, but that solution results in a label that cannot be printed on a sheet feed printer.

Claim 8

Claim 8 makes clear that it is possible to make thickness aid in following the fold line, yet because the label is substantially planar, it can still be printed on any printer. Claim 8 has also been amended to correct a grammatical error.

Claims 9, 10

Regarding claim 9, Cunningham's device does not teach or suggest a darker second layer or for that matter any method by which light density assists in recognizing the fold line. From Cunningham's specification (Column 2, lines 27-30), "the material of which the strip 11 is composed is a well-known transparent sheet material, one form of which is sold as "Scotch" tape". There is no reason for one skilled in the art to draw any implications from the color of the adhesive second layer, and as described in the preferred embodiment, the layer is transparent.

Claim 10 contains all the limitations of claim 9 and the reasons for patentability are the same.

Claims 11-21

The subject matter of amended claim 11 is not taught by the device of Cunningham, which describes a second layer that is not "substantially planar", but has a varying thickness. This argument of claim 1, is likewise applicable and is not repeated. Because claims 12-21 contain further recitations which were argued in the dependencies from claim 1. Similar arguments apply and are not repeasted.

Claims 22-25

Claim 22 includes a recitation that the second layer be darker in color than the first layer, so that the gap is visible through the first layer. Here, color is used to enhance visibility, and the choice of color (or in effect, light transmission density) is functional, not just a design choice. Cunningham makes no mention of color for the "non-transparent paper stock material" of the second layer, and one skilled in the art would not be taught anything about color from Cunningham. Claims 23-25 refer to features also found in other dependent claims and are likewise not taught in the prior art.

Claims 26-29

Claim 26 claims a backing member in addition to the first and second layers. We believe that a backing member is not obvious, and that one skilled in the art would not use the device in Cunningham with a backing member in its design.

The index tabs of Cunningham are distributed on a roll, not in sheets. As with most adhesive tape products on a roll, the sticky side is temporarily attached to the non-sticky side directly beneath it, and is detached when the tape is dispensed. Even common dual-stick tape, on which both sides have adhesive, has no backing member. There is no indication that a roll of index tabs would require a backing member, since an arguably more adhesively complex product, like dual-stick tape, does not use one. Furthermore, the addition of a backing member adds functionality to the labels; one can't run adhesive labels through a sheet-feed printer without using backing members. We therefore request allowance of claim 26 and dependent claims 27-29.

Claims 30-31

We submit that Cunningham does not anticipate claim 30 since the reference does not include each limitation of the claim. In Cunningham's discussion of the application of a label (Column 3, lines 30-36), there is no mention of a "weakened fold-line". Because this element of claim 30 is absent from the prior art, we request allowance of claim 30 and dependent claim 31.

Claims 32-33

Cancelled.

Claim 34

Cunningham does not anticipate claim 34 since the reference does not include each limitation of the claim. For the same reasons as discussed for claim 1, Cunningham does not teach a "substantially planar" first layer. Because this element of claim 34 is absent from the prior art, we request allowance of claim 34.

Though the examiner did not apply the Verhines reference in the present Office Action, it seems appropriate to address this reference to expedite prosecution. The recitation that the first layer be substantially planar is sufficient to also distinguish the present invention also over Verhines (5,996,130) also . Verhines teaches an index tab that may be fed through a printer, in which both sides of the tab are printed at the same

time on one side of a page, then the tab is detached from the page, folded in half on a score line, and attached to the edge of a sheet. The summary from Verhines reads, "When the sheet is subsequently passed through the printer or copier, the desired indicia is printed on each of the tab material units, preferably on both sides of the score lines thereof." Describing Fig. 3, "A score line 114, parallel to edge 78, divides the segments 106 into front and rear panels 116, 118 to facilitate subsequent folding in a later formation step." Verhines' first layer (the surface adapted to being printed on) contains a score line, whereas the first layer of the present invention is "substantially planar", and there are no locating or distinguishing features present in the first layer at all. The present invention folds along the fold line defined only by the gap in the second layer, and not all elements of claim 1 are taught by Verhines.

CONCLUSION

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. The amendments clarify the patentable invention without adding new subject matter. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Michael B. Lasky at (952) 253-4106.

Respectfully submitted,

Altera Law Group, LLC
Customer No. 22865

Date: December 1, 2003 By: _____

Michael B. Lasky
Reg. No. 29,555
MBL/blj